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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,724

03/15/2004

Hansjorg Ander

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2292 7590 10/28/2010
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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1788

NOTIFICATION DATE

DELIVERY MODE

10/28/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/799,724	ANDER ET AL.	
	Examiner	Art Unit	
	ANISH DESAI	1788	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22,24,27,29 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,22,24,26,27,29 and 38-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments in response to the Office action (OA) mailed on 04/15/10 have been fully considered.
2. Support for newly added claim and amended claims (except for the issues raised in this OA under 112-first paragraph for new matter) is found in the specification as originally filed.
3. .In view of applicant's amendment, the 112-first paragraph rejection to claim 43 as set forth in the previous OA is withdrawn.
4. A new claim objection is made in view of newly added claim 46.
5. A new 112-second paragraph rejection is made in view of applicant's amendment.
6. In view of applicant's cancellation of "epoxides" from claim 21 and given that the presently claimed invention recites "**consisting of**" in claims 21 and 46 (see language of "...wherein said material is a cured polymerizable mass **consisting of**..."), the 102(b)/103(a) rejections based on Komiyama et al. (US 5,118,567) are withdrawn because Komiyama teaches epoxy resin (see abstract and column 4 lines 17-21).

Duplicate Claims

7. Applicant is advised that should claim 21 be found allowable, claim 46 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). It is noted that scope of the both claims exclude (note phrase "optionally") various additives (e.g. radiation sensitive initiator, inorganic filler, flame-proofing agent, and colorant). As such, when the aforementioned additives are excluded from the scope of claims 21 and 46; claims 21 and 46 become substantial duplicates of each other. As such, if claim 21 is found allowable, then claim 46 will be objected to as being a substantial duplicate thereof.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 21, 22, 24, 27, 29, and 38-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The**

claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. With respect to claims 21 and 46, it is noted that the present specification (e.g. paragraph 0015, 0022, and 0026 of US PG PUB of this application) provides support to recite that the polymerizable mass consists of "at least one compound selected from the group consisting of aromatic (meth)acrylate, alicyclic (meth) acrylates, polycyclic (meth)acrylates, heterocyclic (meth)acrylates, epoxide acrylates" in combination with acrylic acid and/or methacrylic acid. However, specification fails to provide support for "vinyl ethers, vinyl esters, and styrene" in combination with acrylic acid and/or methacrylic acid as claimed.

10. While applicant points to paragraphs 0024, 0025, and 0015 of Pg Pub of this application for support (see amendment page 10), the Examiner respectfully submits that said paragraphs do not provide support that applicant was in possession of polymerizable mass containing e.g. a cured polymerizable mass consisting of e.g. a vinyl ether with acrylic and/or methacrylic acid. While paragraphs 0024 and 0025 recite vinyl ether, vinyl esters, and styrene, this does not provide support that each of the aforementioned compounds is polymerized with acrylic acid and/or methacrylic acid. Further, the aforementioned paragraph "collectively" can not be interpreted that applicant's polymerizable mass contains at least one compound selected from "vinyl

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ethers, vinyl esters, and styrene" and at least one other compound selected from "acrylic acid and/or methacrylic acid". The Examiner respectfully submits that while there is a support to claim acrylates (e.g. aromatic (meth)acrylate, alicyclic (meth)acrylate etc.) recited in claims as one compound in combination with acrylic and/or methacrylic acid, there is no support to recite "vinyl ethers, vinyl esters, and styrene" in combination with acrylic acid and/or methacrylic acid.

11. Additionally, with respect to claim 21 recitation "optionally, a radiation sensitive initiator in an amount ranging from 0.0 to 5 wt%", specification fails to provide support for "0.0 wt%" of radiation sensitive initiator.

12. Further, with respect to claim 21 recitation "optionally, an inorganic filler in an amount ranging from 0.0 to 10% wt of the polymerizable mass", "optionally, a flame-proofing agent in an amount ranging from 0.0 to to 10% wt. of the polymerizable mass", and "optionally, a colorant in an amount ranging from 0.0 to 2% wt. of the polymerizable mass", the specification as originally filed fails to provide support to recite the amount of the aforementioned ingredients in the range as claimed.

13. While applicant argues that the term "optionally" for each of the aforementioned component provides support for an amount of 0% (see amendment page 10), the Examiner respectfully disagrees. It is submitted that the term "optionally" as recited can only be interpreted as the aforementioned components are "optional" (i.e. not needed), but this does not provide support to create a new range of weight% of the components. The Examiner submits that with respect to each of the "optional" components recited

above in claim 21, there is only support to recite the range as set forth e.g. in paragraphs 0018-0020 of Pg Pub of this application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 21, 22, 24, 27, 29, and 38-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

15. With respect to claims 21 and 46, said claims recite “wherein said material is a **cured polymerizable** mass”, this recitation is indefinite because the terms “cured” and “polymerizable” are when used together creates ambiguity in claim interpretation. Because, “cured” means material that is already ***polymerized***. As such, “cured polymerizable mass” is unclear because it is not clear whether the material is polymerized or polymerizable. The Examiner respectfully suggests that applicant delete “a cured polymerizable mass” and replace it with “produced by polymerization of a polymerizable mass” which better characterizes the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1788

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787